

REMARKS

Reconsideration of the Application respectfully is requested. For the reasons indicated in detail hereafter, the Application is urged to be in condition for allowance.

It respectfully is pointed out that a rejection of the Application under 35 U.S.C. §102(b) over the inadequate teachings of anything published with respect to French Breeders Rights Application No. 16201, and a leaflet edited by 'André Briant dated October, 1999 entitled "Sapho Infos" concerning the 'Inoveris' variety would be inappropriate. There has been a misapplication of the law as contemplated by Congress in the Official Action.

Plants of the 'Inoveris' variety were first available on a limited basis as discussed hereafter solely in the country of France during July 1999 rather than "September 1998" as indicated at Page 6 of the Official Action. Such availability would have gone unnoticed by those interested in Caryopteris plants elsewhere throughout the world. The general public not even in France would have known of the availability of 'Inoveris' plants more than one year prior to the February 26, 2001 effective filing date of the present U.S. Plant Patent Application.

One skilled in the art had no reasonable expectation of reproducing the 'Inoveris' variety in view of anything that was published more than one year prior to Applicant's effective filing date of February 26, 2001.

The *In re LeGrice* decision of the Court of Customs and Patent Appeals dated May 4, 1962 and reported at 133 USPQ 365 is controlling authority for Examiners of the U.S. Patent and Trademark Office and must be followed during the examination when a comparable factual situation is presented as in the present application. It was there held that in order to be a statutory bar, a printed publication with respect to

a new plant variety that is sought to be patented under 35 U.S.C. §§161 to 165 must be adequate in its teachings to enable the reader in combination with scientific knowledge of the particular art to be in possession of the plant when taking into consideration the existing "store of knowledge in fields of plant heredity and plant eugenics which one skilled in the art will be presumed to possess." The two rose varieties under discussion in the *LeGrice* case were available to the public outside the United States well more than one year before the filing dates of the Plant Patent Applications that matured into United States Plant Patent Nos. 2,209 and 2,210.

This is confirmed at Page 2 of the February 12, 1960 *LeGrice* Board of Appeals Decision where it stated:

The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing date of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. (underlining added)

Such availability of plant material of the claimed varieties abroad was not relevant to the examination in view of the express language utilized by Congress in 35 U.S.C. §102. Public use and availability of the subject matter of a Patent Application in a foreign country more than one year before the filing date is not an impediment to United States Patent protection. See, the *Gandy et al. v. Main Belting Co., et al.*, Supreme Court decision cited earlier. The Judges at the Court of Customs and Patent Appeals reasonably can be concluded to have considered the underlying facts and the February 12, 1960 decision of the Board of Appeals in detail. Had the availability of plants of the subject *LeGrice* varieties outside the

United States been considered to be relevant in its evaluation, it would have been addressed in the written decision. Such issue had been resolved by the United States Supreme Court many years earlier and was not open for discussion. This *In re LeGrice* decision that was written by the respected patent jurist, Arthur M. Smith, clarified the law with respect to when a printed publication can serve as a statutory bar to plant variety protection and properly was consistently applied and followed by Examiners of traditional Plant Patents pursuant to 35 U.S.C. §§161 to 165 for several decades following its issuance.

The subsequent decision of the Board of Patent Appeals and Interferences in *Ex parte Thomson*, 24 USPQ 2d 1618 (1992) involving a utility Patent Application was not followed by Examiners of the U.S. Patent and Trademark Office in the past for good reason. It should be recognized to constitute an ill-conceived action by the Patent Office administrative tribunal that is unsound from both technical and legal standpoints. It has never been the law with respect to non-plant inventions when similar enablement issues with respect to a publication arise. 35 U.S.C. §102 was misapplied in *Thomson*. There is no reason for the law in this area to be different when applied to a plant invention. Further the fact situation in the *Thomson* case cannot reasonably be distinguished from that of the controlling Court authority with respect to traditional Plant Patents - *In re Le Grice*. In both instances, there was public use and availability of plant material outside the United States more than one year before the United States filing dates. Also, the cavalier "someday is here" reasoning expressed in the *Thomson* decision should be recognized to be scientifically inaccurate. From a scientific standpoint there is today no way that even the most skilled plant scientist could reproduce the claimed 'Inoveris' variety from a

reading of anything that was published with respect to this variety more than one year prior to the February 26, 2001 effective filing date. The mere possibility for one to seek a plant in a foreign country and to bring such plant to the United States has never been an impediment to variety protection in the United States in the absence of a showing that the variety was on sale or in public use in the United States more than one year before the United States filing date. No statutory anticipation has been or is capable of being established with respect to the 'Inoveris' variety.

As specified at 35 U.S.C. §161, Plant Patents and Patents for other inventions are subject to the same statutory provisions "except as otherwise provided." Title 35 provides no exception capable of supporting a different rule for Plant Patents. The Court of Appeals for the Federal Circuit in *In re Wilhelm Elsner* had no authority under the U.S. Constitution to seek to change the content of 35 U.S.C. § 161 as enacted by Congress and clearly was in error when it stated:

Because we perceive a difference between plants and statutorily distinct inventions, we disagree with Appellants' contention that this holding will operate to create a printed publication bar whenever a non-enabling publication and foreign sale are involved.
(underlining added)

Accordingly, a rejection under 35 U.S.C. § 102(b) would be inappropriate since Congress has stated no difference between plant inventions and other statutory inventions in the area of a novelty defeating statutory bar. The distinction cited by the Examiner at Page 6, first full paragraph, of the Official Action is completely irrelevant with respect to a novelty defeating statutory bar analysis.

The availability of a claimed invention in a foreign country more than one year prior to the filing of a United States Patent Application does not constitute "prior art" in view of the express language specified by Congress in 35 U.S.C. § 102. It

respectfully is pointed out that the availability of an invention in a foreign country was not a novelty defeating event recited in 35 U.S.C. § 102.

No publication with respect to French Plant Breeders Application No. 16201 indicated that plants of the 'Inoveris' variety were available to the public anywhere. Such publications were non-enabling and provided no information to the reader concerning the availability of plants of the 'Inoveris' variety to the general public anywhere.

The October 1999 technical publication edited by André Briant entitled 'Sapho Infos' also was non-enabling and was isolated in its distribution since it was provided to a limited number of French plant professionals and briefly discussed new plant varieties that were being developed in France. It is understood that no information was included in the publication concerning the availability of the 'Inoveris' variety to the general public anywhere. This publication appeared solely in the French language, was limited in its distribution, was not provided to the general public even in France, and was not provided to persons interested in Caryopteris plants in the other 150+ civilized countries of the world.

As indicated in the information provided on August 26, 2002, some plants of the 'Inoveris' variety were provided to some members of the public in the single country of France as early as July 1999. However, there is no way that the general public at large could have learned of this availability even in the single country of France. Nothing was published more than one year prior to the February 26, 2001 effective filing date of the present U.S. Plant Patent Application that would have informed the general public of the availability of plants of the 'Inoveris' variety. Accordingly, the general public of ordinary skill in the art possessed no knowledge

with respect to the enablement of an otherwise non-enabled printed publication bearing a sufficiently early publication date.


The pages from André Briant Jeunes Plants, Tarif Général, Saison 1999/2000 which include reference to the 'Inoveris' variety at the middle of the second page were provided exclusively to a limited number of plant professionals located in the single country of France during August 1999. It is significant that this list was never provided to the general public anywhere. The general public even in France would never have known of the availability of plants the 'Inoveris' variety at any location. This list would have gone unnoticed elsewhere in the world were the vast majority of those persons interested in Caryopteris plants reside. The limited availability of 'Inoveris' plants more than one year prior to Applicant's February 26, 2001 effective filing date was indeed isolated and remote even if the reasoning expressed in the *In re Wilhelm Elsner* decision were followed. When isolated and remote the plant availability is to be disregarded.

For the foregoing reasons, it respectfully is submitted that no novelty defeating event has taken place with respect to 'Inoveris' variety and accordingly the withdrawal of the 35 U.S.C. § 102(b) rejection respectfully is requested.

Respectfully submitted,

BUCHANAN INGERSOLL PC (INCLUDING ATTORNEYS
FROM BURNS DOANE SWECKER & MATHIS)

Date: February 23, 2006

By: 
Benton S. Duffett, Jr.
Registration No. 22,030

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620